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P. DeLoatch
PATENT 03/06/03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : RICHARD J. TETT
Serial No. : 09/136,839
Filed : August 20, 1998
For : SYSTEM AND METHOD FOR RETRIEVING AND
DISPLAYING PAGING MESSAGES
Group No. : 2635
Examiner : M. Shimizu

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Commissioner for Patents
Washington, D. C. 20231

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Sir:

APPELLANT'S REPLY BRIEF

This Reply Brief is submitted in triplicate on behalf of Appellant for the application identified above in response to the Examiner's Answer (Paper No. 20) mailed December 24, 2002.

Appellant respectfully notes that Appellant's Brief on Appeal does contain a statement regarding related appeals and interferences (on page 2, immediately following the identification of the real party at interest).

Furthermore, Appellant's Brief on Appeal states that the claims of Group A (claims 1-20) and the claims of Group B (claim 21) stand or fall independently, and patentability is separately argued.

ARGUMENT

In reply to the Response to Argument in the Examiner's Answer (Paper No. 20, pages 12-13), Appellants respectfully offers the following observations:

1. **The claimed feature of storing a wireless message previously delivered to the subscriber is not depicted or described by either cited reference, taken alone or in combination.**

As previously noted, independent Claim 1 of Group A recites a message retrieval controller capable of accessing a data record (associated with a subscriber) containing one or more stored wireless messages directed to the subscriber, and including at least one stored message which was previously delivered to the subscriber.

Such a feature is not depicted or described in either *Davis* or Octel-94. The Examiner's Answer asserts that:

Davis is not cited for storing the message, rather Octel-94 teaches storing messages which was previously delivered (note; pages, iii, 1-3 and 6, saved or archived after delivery) as claimed in claim 1.

Paper No. 20, page 12. However, the entire content of page iii of the Octel-94 references is reproduced below:

GETTING STARTED

After your system manager has given you a temporary password and explained how to initialize your mailbox, you will be ready to begin. Then, by using the Table of Contents and Index, you can quickly locate any feature you wish to use. Most new users read this guide from cover to cover to familiarize themselves with all of the system features.

Reading the instructions in this guide and following the At-a-Glance diagram on the inside back cover will help keep you on track. Once you've had a little experience using the system, you'll find Octel's friendly voice prompts are all you need to guide you through the many options available.

You will focus on the basics at first: entering your mailbox, listening to messages, and sending messages. Before you know it, you will be able to use any feature you choose.

The Octel system has its own phone number and you call it just like you would call any telephone, as long as you have a touchtone keypad. When you enter the system as a subscriber you will begin at the Main Menu. To reach the Main Menu, just follow the voice prompts to enter your mailbox.

When calling from outside the company:

1. Call the Octel system phone number _____.
2. Listen to the introductory system greeting.
3. Press **#** to indicate you have a mailbox on the system.
4. Enter your mailbox number _____.
5. Enter your password _____.
6.and now you are at the Main Menu.

When calling from your office phone:

1. Call the internal Octel system phone number _____.
2. Enter your password _____.
3.you are at the Main Menu.

You may now review messages that have been sent to you and send messages to other subscribers. Later, you will use the Main Menu to access other features. Listen carefully to the voice prompts and follow the At-a-Glance diagram.

NOTE: Depending on the way your system is set up, some features may not be available to you and you will not be prompted for those options.

Octel-94, page iii. This cited portion of Octel-94 contains no description of saving wireless messages that have been delivered. Octel-94 merely describes an End-of-Message Option for saving a voice mail after hearing that voice mail (Octel-94, page 1) and notes that "Saved

messages are 'archived' for a time specified by your system manager." (Octel-94, page iv). Thus, Octel-94 merely describes saving a voice mail (i.e., recorded audio) message after playback, and is silent as to saving a wireless message after delivery to the subscriber as recited in the claims of Group A.

Moreover, Octel-94 relates to a telephone voice messaging system (i.e., "voice mail"), not to a wireless messaging ("pager") system. Telephone messaging systems are designed to record messages for users (e.g., employees of an enterprise) that are not able to answer a telephone call due, for example, to absence from the office or use of the telephone in connection with another call. Wireless messaging systems, on the other hand, are designed to immediately deliver a text message (i.e., a phone number and/or other text) in real time via radio communications to a paging device carried by the subscriber, regardless of the subscriber's location or activity. Due to the fundamental differences between the two types of systems (text message delivery versus voice mail storage), Octel-94 is not an analogous reference to the claimed invention or *Davis*.

Regardless, the ability to save received voice-mail in a telephone messaging system, which is designed to store voice messages, does not inherently suggest a motivation or incentive to save wireless messages in a wireless messaging system, which is designed for essentially instantaneous delivery of the wireless (text-based) message.

The Office Action proposes to selectively combine a portion (the End-of-Message “Save” Option for saving a voice mail after playback) of the disclosure of Octel-94 with the disclosure of *Davis* to “assure the successful transfer of any message.” However, it is not apparent how saving a voice mail after playback would effectuate such an assurance of transfer of any wireless paging message, and the Office Action contains no explanation of how the proposed combination would achieve this result. *Davis* merely describes saving messages prior to delivery, without suggesting any need for saving wireless messages after delivery, while Octel-94 merely describes user options for a conventional voice mail (NOT wireless messaging) system. Absent some mechanism for redelivery of previously delivered wireless messages, which is not described in *Davis*, the proposed combination does not achieve the solution suggested in the Office Action.

Neither the Office Action nor the cited references themselves provide a reasonable expectation of successfully combining the references in the manner disclosed. It is not self-evident how a voice mail storage mechanism could be incorporated into a wireless message delivery system to achieve the solution proposed in the Office Action.

The Office Action also fails to identify a specific motivation or incentive for modifying the teachings of *Davis*, which teaches storing lengthy messages prior to delivery, to further include storing messages after delivery as purported described by Octel-94. The mere storage of messages in one manner and for one purpose (prior to delivery, to facilitate delivery) does

not necessarily suggest the desirability of also including similar storage in another manner for a completely different purpose (after delivery, to facilitate review). The Office Action identifies no need or problem identified in the prior art relating to wireless messaging that is or would be satisfied by or overcome by inclusion of storage of wireless messages after delivery. As previously noted, the specification teaches that messages transmitted by a wireless messaging system to the subscriber may not reach the subscriber due to the subscriber's paging device ("pager") being turned off, the subscriber being out of the service area, or interference with the signal, where such messages may be lost in prior art if transmitted and then deleted. Thus, the Applicant's teachings provide an incentive for saving wireless messages after nominal delivery, to allow subsequent review and retrieval by the subscriber of messages not actually received. The Office Action improperly employs the Applicant's teachings as a motivation for the proposed combination, during hindsight reconstruction of the claimed invention using the claims as a template.

2. **The claimed feature of transferring selected review information regarding the stored, previously delivered message to the subscriber is not depicted or described by either cited reference, taken alone or in combination.**

As previously noted, independent Claim 1 of Group A recites a message retrieval controller capable of transferring, to the selected subscriber, selected review information relating to at least one stored message that was previously delivered to the subscriber. Such a

feature is not depicted or described in either *Davis* or Octel-94. In response, the Examiner's

Answer states:

Regarding appellant's argument (lines 3-6, page 10), the examiner maintains that *Davis* is not cited for storing the message, rather Octel-94 teaches reviewing previously delivered and saved messages (note; pages, iii, 1-3 and 6, listening to a message by skipping to archived messages) as claimed in claim 1.

Paper No. 20, page 12. However, whether *Davis* teaches storing messages or not is not relevant to the claim limitation at issue, and Octel-94 does not describe "skipping to archived messages" as asserted in the Office Action. More significantly, neither reference describes transmitting selected review information relating to a saved, previously delivered wireless message to the subscriber, as recited in the claims. Replaying a previously saved voice mail as described in Octel-94 does not involve transmission of selected review information.

3. **The rejection fails to identify a motivation or incentive to saving previously delivered wireless messages at the delivery point rather than within the paging device, as recited in the claims.**

The Examiner's Answer asserts:

Regarding appellant's argument (line 9-15, page 11), the examiner maintains that Octel-94 provides reasons why one would retain messages such as for later review, or for keeping important messages.

Paper No. 20, page 12. Octel-94 contains no description of "keeping important messages" as asserted in the Office Action, and retaining already stored voice mail differs from storing a delivered wireless message "for later review." More significantly, however, the claims of Group A relate to a message distribution system including a controller for responding to

message retrieval requests. The claims of Group A recite storing the data record containing the stored, previously delivered wireless message at the controller for responding to message retrieval requests. Neither the Office Action nor the Examiner's Answer identify any specific motivation or incentive for storing previously delivered wireless message "for later review" at the message distribution system, as recited in the claims of Group A, rather than within the subscriber's paging device, as was conventional at the time the invention was made.

4. The claims do recite various feature dismissed in the Examiner's Answer.

The Examiner's Answer asserts that various limitations relied upon by the applicant are not recited in the claims. Specifically, the Examiner's Answer states:

Regarding appellant's argument (lines 6-12, page 12), the examiner maintains that claims do not distinguish these features; that is, the attachment type and size field allows the subscriber to advantageously determine what the attachment is before requesting the attachment be downloaded to the subscriber, and messages actually transmitted by the paging system do not reach the subscriber due to the pager being turned off, the pager is located out of the area, or interference with the signal.

Paper No. 20, page 13. However, the independent claims of Group A do recite transmitting selected review information, which dependent claims clarify includes "only one or more selected fields from at least one stored message." The selected fields, as taught by the specification, may include attachment size and type to allow the user to decide whether to request download of the entire message. Moreover, the independent claims of Group A recite storing messages that were previously delivered to the subscriber, which includes messages that

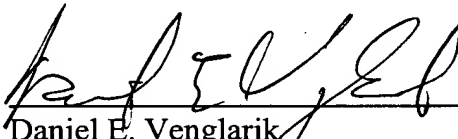
were nominally delivered but never actually received at the subscriber's paging device for the reasons specified.

None of the cited references, taken alone or in combination, depict or describe all features of the invention claimed in Groups A-B. Therefore, the rejection under 35 U.S.C. § 103 is improper. Applicant respectfully requests that the Board of Appeals reverse the decision of the Examiner below rejecting all pending claims in this application.

Respectfully submitted,

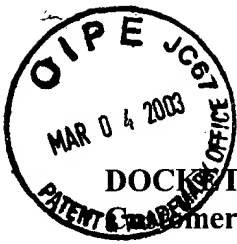
DAVIS MUNCK, P.C.

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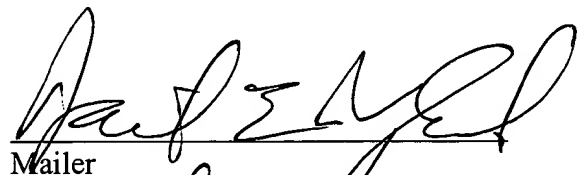
The undersigned hereby certifies that the following documents:

- 1) Appellant's Reply Brief (in triplicate); and,
- 2) Postcard receipt.

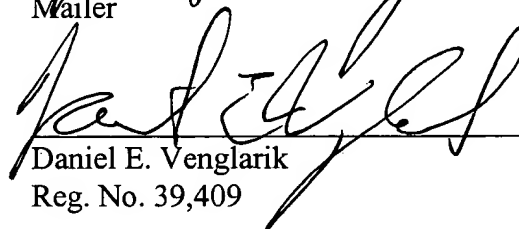
relating to the above application, were deposited as "First Class Mail", with the United States Postal Service, addressed to BOX AF, Commissioner for Patents, Washington, D.C. 20231, on February 24, 2003.

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